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Atty. Docket No.: 0059-014P1

### REMARKS

These remarks are in response to the Notice of Appeal filed May 23, 2008, which has a shortened statutory period for filing an appeal brief set to expire July 23, 2008. A four-month extension, to expire November 24, 2008 (November 23 being a Sunday), is requested in a petition filed herewith.

#### Interview Summary:

An interview was held between Examiner Dionne Pendleton and Applicants' attorney, Larry E. Henneman, Jr., on November 3, 2008 to discuss the prior art rejections made in the Office Action dated November 26, 2007. With respect to U.S. Patent No. 5,737,436 (Boyden), Mr. Henneman initially indicated that the press fit connection between the tubular member 14 and the fitting 30 (FIG. 2) was not an adjustment mechanism. However, the Examiner disagreed.

Mr. Henneman and Examiner Pendleton then discussed the best way to advance the prosecution of the case. Examiner Pendleton suggested that the Office might give favorable consideration to Claim 24 if Claim 24 was amended to further define the structure and operation of the "retainer" element. Mr. Henneman and Examiner Pendleton discussed some possible language that could be amended into Claim 24, but no agreement was reached.

Applicants and Mr. Henneman thank Examiner Pendleton for the constructive nature of the interview.

#### Claims

Claims 1-28 are pending in the above-identified application. Claims 1-28 are rejected over prior art. Claims 1, 3-4, 6-9, 16, 18-19, and 23-24 are amended and Claims 29-39 are added. Claims 5, 10-15, and 22 are canceled. Claims 2, 17, and 20-21 remain as filed, and Claims 25-28 remain as previously presented. Reconsideration is requested.

#### Rejections Under 35 U.S.C. § 102

Claim 24 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,737,436 (Boyden).

Applicant respectfully requests reconsideration in view of the amendments made herein.

The standard for anticipation is set forth in M.P.E.P. § 2131 as follows:

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"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

As amended herein, Claim 24 recites (in part) "a retainer including a raised ring on one of the connecting tube and the elongated projection and a retaining ridge on the other of the connecting tube and the elongated projection" and that "the raised ring abuts the retaining ridge when the connecting tube is moved longitudinally away from the elongated projection such that the retainer facilitates positional adjustment between the connecting tube and the elongated projection but prevents disengagement of the connecting tube and the elongated projection." Boyden does not disclose these elements. Rather, Boyden discloses a tubular member 14 (FIG. 2) that can be pressed onto the tubular fitting 30 that is connected to the foam insert 20 (*Boyden*, col. 6, lines 17-23). Alternatively, a transducer 50 can be placed around the end 18 of the tubular member 14 (FIG. 4; col. 7, lines 18-23). However, Boyden does not disclose a retainer as recited by Claim 24. Therefore, Boyden does not anticipate Claim 24.

For the above reasons Applicants request reconsideration and withdrawal of the rejections under 35 U.S.C. § 102.

#### Rejections Under 35 U.S.C. § 103

Claims 1-22 are rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,009,183 (Taenzer et al.) in view of U.S. Patent No. 5,737,436 (Boyden).

#### Claims 1-17:

The Examiner writes (in part):

Regarding claim 1, TAENZER teaches a communication earpiece comprising: A transducer portion (22) having a transducer housed therein (see column 3, lines 5-7); in column 4, lines 27-30, Taenzer teaches a sound horn (16); and a generally tubular connection member (14) for channeling sound from the transducer enclosure portion to the sound horn (16); wherein column 3, lines 28-32 teaches a connection member (14) having a first adjustment

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means (30) for allowing rotation of the connection member relative to the transducer enclosure portion.

TAENZER does not clearly teach a second adjustment means allowing movement of the sound horn selectively toward or away from the transducer enclosure portion.

BOYDEN teaches, in figure 2, a second adjustment means (18, 30) for connecting a sound horn (20) to a connection member (18), wherein the second adjustment means (18, 30) allows movement of the sound horn (via smooth inner and outer surfaces of articles 18 and 30, respectively) selectively toward and/or away from the transducer enclosure via sliding motion, see figure 2 which illustrates that the connecting tube (14, 18) is disposed at the mid-length portion of projection (30).

It would have been obvious for one of ordinary skill in the art at the time of the invention to combine the teachings of Taenzer and Boyden, substituting the sound horn/sound tube connection (18, 30) structure taught by figure 2 of Boyden, for the unitary connection between tip (16) and tube (14) in Taenzer, thereby providing a releasable connection to the ear tip and also permitting the exchange of ear tips so as to enable a more comfortable fit for the user, if so desired.

Applicant respectfully requests reconsideration in view of the amendments made herein.

As amended herein, Claim 1 recites (in part) that "the connection member has a second adjustment means for allowing movement of the sound horn selectively toward and/or away from the transducer enclosure portion and for allowing rotation of the sound horn in relation to the connection member," that "the second adjustment means includes a retainer having a raised ring on one of the hollow cylindrical projection on the sound horn and the hollow cylindrical end portion on the connection member and a retaining ridge on the other of the hollow cylindrical projection on the sound horn and the hollow cylindrical end portion on the connection member" and that "the raised ring abuts the retaining ridge when the sound horn is moved longitudinally away from the connection member such that the retainer facilitates positional adjustment between the sound horn and the connection member but prevents disengagement of the connection member and the sound horn." Neither of the cited references discloses these elements of amended Claim 1.

As indicated by the Examiner, Taenzer et al. does not teach or suggest means that allow movement of the sound horn selectively toward or away from the transducer enclosure portion, such as the elements recited in amended Claim 1. In addition, Boyden also does not teach or suggest the same device as recited by amended Claim 1. As stated above, Boyden teaches a

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tubular member 14 that is press fit onto the tubular fitting 30 of the foam insert 20 (*Boyden*, FIG. 2; col. 6, lines 17-23). Whatever, adjustment abilities that the device of *Boyden* provides, which Applicant respectfully avers is negligible at best, *Boyden* does not teach or suggest a retainer wherein "the raised ring abuts the retaining ridge when the sound horn is moved longitudinally away from the connection member such that the retainer facilitates positional adjustment between the sound horn and the connection member but prevents disengagement of the connection member and the sound horn," as recited by amended Claim 1. Therefore, because neither of the cited references disclose all the elements of amended Claim 1, no prima facie case of obviousness is established with respect to Claim 1.

Furthermore, neither of the cited references provide any suggestion or motivation for modification to arrive at the communications carpiece of amended Claim 1. For instance, Applicants acknowledge that *Taenzer et al.* discloses an annular groove 36 on the connector 30 and an annular ring 38 on the sound output port 32 that provide a "snap-fit" coupling (*Taenzer et al.*, col. 3, lines 33-44). However, *Taenzer et al.* does not indicate that this snap-fit coupling could or should be modified to provide "movement of the sound horn selectively toward and/or away from the transducer enclosure portion" and "rotation of the sound horn in relation to the connection member" as recited by amended Claim 1. Additionally, *Taenzer et al.* also does not indicate that it would be desirable to modify an adjustable connection with a retainer that facilitates positional adjustment but further prevents components from disengaging after a particular position of adjustment.

Furthermore, *Boyden* neither teaches or nor suggests any physical structure on the foam insert 20, the tubular member 30, or the tubular member 14 that facilitates rotational and longitudinal adjustment but also retains the connection between tubular members 14 and 30 by preventing the tubular members 14 and 30 from disengaging at a particular point of longitudinal adjustment. Rather, *Boyden* does not appear to be concerned with the adjustment of the tubular member 30 in the tubular member 14. For example, the tubular member 14 is secured to the foam insert 20, for example, by an adhesive or a press fitting (col. 6, lines 18-23) indicating that the foam insert 20 is not supposed to rotate or move longitudinally. Furthermore, even assuming that the ear insert member 20 can be rotated, because the ear insert member 20 is symmetrical about the axis of tubular members 14 and 18, there would be no adjustment benefit in rotating the ear insert member 20 about that axis.

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Therefore, for at least the above reasons, the cited prior art provides no suggestion or motivation for modifying the cited references to obtain the communications earpiece of amended Claim 1. Because no suggestion or motivation for modifying the cited references exists, no prima facie case of obviousness is established with respect to amended Claim 1.

In the Office Action, the Examiner provides several rationales for modifying Taenzer et al. with the teachings of Boyden to obtain the claimed invention. In particular, the Examiner states that Taenzer et al. would modify his sound delivery system 10 with the connection taught in FIG. 2 of Boyden to provide "a releasable connection to the ear tip and also permitting the exchange of ear tips so as to enable a more comfortable fit for the user, if so desired." However, Taenzer et al. already provides a solution for those reasons cited by the Examiner, and therefore, the Examiner's reasons for modification are insufficient to establish a prima facie case of obviousness. For example, Taenzer et al. provides that the snap-fit coupling between the groove 36 and the annular ring 38 provides easy replacement of the sound delivery tube 14 and the eartip 16 (col. 3, lines 46-48). Taenzer et al. also provides that "the flexibility of the sound delivery tube material allows one size tube to fit substantially all ear shapes and sizes" (col. 4, lines 7-9) and that "variations in ear canal depth can be accommodated by allowing the eartip 16 to enter the canal to different depths or allowing the bend 48 of the tube to extend further out of the ear canal into the bowl or concha of the ear" (col. 4, lines 15-18). Accordingly, adding a connection taught by Boyden to Taenzer et al. to provide for releasable and exchangeable eartips 16 would only add extra components to the sound delivery system 10 of Taenzer and would not provide any new benefit. Therefore, because there is no motivation to modify the references as suggested by the Examiner, no prima facie case of obviousness is established with respect to amended Claim 1.

For the above reasons, because the cited prior art do not disclose all the elements of amended Claim 1 and because there is no suggestion or motivation to combine the references to obtain the claimed invention, no prima facie case of obviousness is established with respect to amended Claim 1. Claims 2-4, 6-9, and 16-17 depend, either directly or indirectly, from amended Claim 1 and are, therefore, distinguished from the cited prior art for at least the reasons provided above with respect to amended Claim 1.

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Claims 18-22:

As amended herein, Claim 18 recites (in part) "the connection member can be moved longitudinally along at least a portion of the length of at least one of the first generally hollow projection and the second generally hollow projection" that "the raised ring of the first retainer abuts the retaining ridge of the first retainer such that the first retainer facilitates positional adjustment between the connection member and the first generally hollow projection but prevents disengagement of the connection member and the first generally hollow projection" and that "the raised ring of the second retainer abuts the retaining ridge of the second retainer such that the second retainer facilitates positional adjustment between the connection member and the second generally hollow projection but prevents disengagement of the connection member and the second generally hollow projection." Therefore, for the same reasons provided above with respect to amended Claim 1, no prima facie case of obviousness is established with respect to amended Claim 18. Claims 19-21 depend directly from Claim 18 and are, therefore, distinguished from the cited prior art for at least the reasons provided with respect to Claim 18.

Claim 22 is canceled herein, thereby obviating the rejections of Claim 22.

Claims 23 and 25-28:

Claims 23 and 25-28 are rejected under 35 U.S.C. § 103 as being unpatentable over Taenzer et al. and Boyden and further in view of U.S. Pat. App. Pub. No. 2002/0181728 (Connors et al.)

Claim 23 is amended herein to depend from Claim 24. As stated above, Boyden does not disclose all the elements of amended Claim 24. Furthermore, for the same reasons provided above with respect to amended Claim 1, no prima facie case of obviousness can be established with respect to amended Claim 24. Like Taenzer et al. and Boyden, Connors et al. does not teach or suggest "a retainer including a raised ring on one of the connecting tube and the elongated projection and a retaining ridge on the other of the connecting tube and the elongated projection" or that "the raised ring abuts the retaining ridge when the connecting tube is moved longitudinally away from the elongated projection such that the retainer facilitates positional adjustment between the connecting tube and the elongated projection but prevents disengagement of the connecting tube and the elongated projection" as recited by amended Claim 24.

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For the above reasons, because no prima facie case of obviousness is established with respect to Claim 24, no prima facie case of obviousness is established with respect to Claim 23. Claims 25-28 depend directly from Claim 23, and are, therefore, distinguished from the cited prior art for at least the same reasons as amended Claim 23.

For the above reasons Applicants request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103.

#### New Claims

New Claims 29-39 are added. Support for new Claims 29-39 is provided at least in FIG. 5 and its associated description at page 9, line 18 to page 10, line 23. No new matter is added.

Claims 29-33 depend either directly or indirectly from Claim 1 and are, therefore, distinguished from the cited prior art for at least the same reasons provided above with respect to Claim 1.

Claims 34-39 depend either directly or indirectly from Claim 24 and are, therefore, distinguished from the cited prior art for at least the same reasons provided above with respect to Claim 24.

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For the foregoing reasons, Applicants believe that Claims 1-4, 6-9, 16-21, and 23-39 are in condition for allowance. Should the Examiner undertake any action other than allowance of Claims 1-4, 6-9, 16-21, and 23-39, or if the Examiner has any questions or suggestions for expediting the prosecution of this application, the Examiner is requested to contact Applicants' attorney at (269) 279-8820.

Respectfully submitted,

Date: 11/24/08

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**CERTIFICATE OF FACSIMILE TRANSMISSION (37 CFR 1.8(a))**

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being transmitted via facsimile, on the date shown below, to: MS RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, at (571) 273-8300.

Date: 11/24/08

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